

## **REMARKS/ARGUMENTS**

### ***Amendments in General***

1. Claim 23 has been canceled from the application.
2. Claims 1-3, 5-9, 11-20, 24-26 are pending in the application.
3. New claims 24-26 are added in this Amendment.

### ***Claim Rejections - 35 USC § 102***

4. The Examiner rejected pending claims 1-3, 5-9, 11-13, 16-18, 20, 22 and 23 under 35 USC §102(b) as being anticipated by WO 00/09825 (Atkins).
5. Claim 23 has been canceled from the application, which leaves claim 1 as the only remaining independent claim in the application rejected by the Examiner at this time.
6. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d. 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 828 F.2d 1226,1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). MPEP § 2131.
7. The claims comprise an amended claim 1 in which the feature "in a predictable and controlled manner" has been added. No new matter has been added in said amendment.
8. Applicant believes that claim 1 is novel and inventive over the prior art because the toilet outlet seal of Atkins does not deform in a predictable and controlled manner.

Referring to page 14, lines 2 to 4, Atkins states the vertical body member will tend to collapse, either by radially inward or outward compression. The reference to collapsing and the option of compressing either radially inwards or radially outwards suggest the deformation of this seal is not predictable and is not controlled.

9. As stated in the present application as filed, on page 3 from line 20, "[t]his arrangement not only allows an effective seal to form between the rolled lip and the toilet bowl, but the rolling action reduces the unpredictable slippage between the bowl and the lip."
10. Further advantages are described on the same page in the sentence beginning on line 26, "[f]urther, the predictable rolling action of the lip reduces the likelihood of buckling of the lip or other parts of the body which would affect the formation of a seal, and reduces the need for maintaining accurate alignment of the toilet and the seal during installation."
11. Finally, referring to page 9, the sentence beginning at line 24, the present application states that "[f]urther, the rolling action of the lip provides for predictable and recoverable deformation of the lip as the toilet is lowered on to the lip, such that precise alignment of the toilet is not necessary to prevent buckling of the seal."
12. Applicant submits that claim 1, as currently amended, overcomes the citation of Atkins against the present application in that the present invention as described in the claims above is not anticipated by this reference.

***Claim Rejections - 35 USC § 103***

13. The Examiner rejected claims 14, 15 and 19 under §103(a) as being unpatentable (obvious) in view of WO 00/09825.
14. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. ***Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP § 706.02(j). (emphasis added).
15. As discussed above, the claims of the present invention (as amended) are not anticipated by the prior art. Therefore, a *prima facie* case of obviousness has not been made.

*New Claims 24-26*

16. New claim 25, effectively containing the ridge limitations of claims 14 and 15, and claim 26 describing the rolling action has been added. A new dependent claim (claim 24) has also been added.

17. New claim 25 recites the originally filed features of claims 1, 14 and 15. The Examiner previously dismissed this combination as being obvious in view of Figures 6 and 17 of Atkins.

18. The Examiner states that ridges are taught by Figure 17 of Atkins. Applicant disagrees. The protrusions shown on Figure 17 that the Examiner is referencing to are localized radiused protrusions which are, in fact, a plurality of vertically projecting O-ring seals. This is referenced on page 18 of Atkins in the paragraph beginning at line 26. A number of localized radiused protrusions are not the same as a ridge.

The continuous ridges or ribs of the present application serve to increase the friction between the toilet and the lip, and maintain the desired rolling movement of the lip and formation and maintenance of the sealing contact. The use of ribs circumferentially extending around the lip provides the thick points and narrow points on the lip which assist in the rolling action in the desired radial direction. This feature would not be achievable with protrusions, particularly if the protrusions are not aligned.

Applicant submits claim 25 is also novel and inventive over the prior art.

19. Finally, new claim 26 describes the rolling action of the lip by stating that the lip is arranged such that the lip rolls radially towards a configuration in which the lip and part of the body define a tube. This is clearly not taught by Atkins, as the purpose of Figure 6 is to maintain the lip, that is the upper disc 52, in the same horizontal configuration with respect to the lower disc member 54 "such that they are compressed together to form the seal between the upper flange portion 10 and the toilet bowl 5." There is no rolling of the lip towards the body to form a tube. This amendment is supported by the application as filed, at page 10, in the sentence beginning on line 6.

20. Such changes add no new matter.

**CONCLUSION**

Entrance of these amendments as well as the consideration and allowance of the application as amended is respectfully requested.

If the Examiner has any questions in regard to this response they are invited to phone the undersigned below.

DATED this 3<sup>rd</sup> day of November, 2006

Very respectfully,



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